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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,918	03/11/2004	Pier Fortunato Bottan	FR920020005US1	7014
35525 7590 09/27/2007 IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER KESSLER, MATTHEW E	
			ART UNIT 2109	PAPER NUMBER
			MAIL DATE 09/27/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/798,918

Applicant(s)

BOTTAN ET AL.

Examiner

Matthew E. Kessler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 1 and 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to the application filed on March 11th, 2004. Claims 1-7 are pending examination.

#### ***Claim Objections***

2. Claim 1 and 4 are objected to because of the following informalities:

Claim 1 has a misspelling. Characterised should be changed to characterized.

Claim 4 has a misspelling. Characterised should be changed to characterized.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Raghunandan et al. (hereinafter Raghunandan) U.S. Patent No. 6,721,785.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claim 1, Raghunandan teaches a method of sending an electronic mail ( e-mail) message, comprising, under the control of a mail user agent (column 3 lines 5-13. Raghunandan describes a method for transmitting email... including providing transmission control directives by the user.):

having a user providing an indication of e-mail addresses of intended message recipients (column 3 lines 5-12 teach “A method for transmitting e-mail to a plurality of recipients identified by one ore more aliases in identified list or lists of recipients.” Which is controlled through “directives by the user”), and

based on said indication by the user, generating a list of destination e-mail addresses (column 3 lines 5-25 teaches aliases are provided as the recipients and are expanded if it includes one or more aliases that are nested in an alias. Furthermore an alias is defined in column 2 lines 1-2 “an alias may correspond to a group of email addresses and may further make reference to other aliases.), and

causing the message to be electronically delivered to each of the e-mail addresses in the list, characterised by comprising:

enabling the user providing an indication of at least one excluded e-mail address (column 3 lines 20-24 teach “applying each said parsed transmission control directive on said aliases in said identified list or lists of recipients so as to exclude or include a recipient or a group of recipients in said identified list or lists.”), and

modifying the list so that the message is not delivered to the at least one excluded e-mail address (column 3, lines 26-28 teach “The recipients are included or excluded from said identified list or lists based on the order in which the inclusion or exclusion is defined.”).

As to claim 2, Raghunandan teaches the method of claim 1, in which said act of having the user providing an indication of e-mail addresses of intended message recipients includes having the user globally specifying at least one pre-defined group (GROUPa) of e-mail addresses, and said act of generating the list includes putting in the list each of the e-mail addresses of the globally-specified group (column 3 lines 5-12 teaches “said method includes selectively enabling or denying the transmission of email to identified recipients or groups of recipients in any of said aliases.” Column 1 lines 64-67 teach “very often a recipient or group of recipients who are frequently contacted, are identified by an alias.”).

As to claim 3, Raghunandan teaches the method of claim 1, in which said act of enabling the user to provide an indication of at least one excluded e-mail address includes having the user globally specifying at least one pre-defined group (GROUPb) of e-mail addresses to be excluded, and said act of modifying the list includes removing from the list each of the e-mail addresses of the globally-specified group of e-mail addresses to be excluded (column 3 lines 5-12 teaches “said method includes selectively enabling or denying the transmission of email to identified recipients or groups of recipients in any of said aliases.” Column 1 lines 64-67 teach “very often a recipient or group of recipients who are frequently contacted, are identified by an alias.”).

As to claim 4, Raghunandan teaches a computer program in a working memory of a computer, for sending an electronic mail ( e-mail) message, comprising a mail user agent including means for (column 4 lines 32-36 teaches “the present invention provides a computer program product comprising a computer usable storage medium having computer readable code embodied therein for causing a computer to transmit email to a plurality of recipients” It is interpreted that the program which is in a storage medium which causes a computer to transmit email reads on a computer program in a working memory of a computer. Raghunandan also discloses a computer and network as the means for the following steps.):

having a user providing an indication of e-mail addresses of intended message recipients (column 4 lines 35-36 teach “causing a computer to transmit email to a plurality of recipients”) and

based on said indication by the user, generating a list of destination e-mail addresses (column 4 lines 32-53 teaches aliases are provided as the recipients and are expanded if it includes one or more aliases that are nested in a different alias. Furthermore an alias is defined in column 2 lines 1-2 “an alias may correspond to a group of email addresses and may further make reference to other aliases.), and

causing the message to be electronically delivered to each of the e-mail addresses in the list, characterised by comprising:

enabling the user providing an indication of at least one excluded e-mail address (column 4 lines 48-53 teach “computer readable code devices for application of each said parsed transmission control directive on said identified list or lists of recipients so as to exclude or

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include a recipient or a group of recipients in said identified list or lists, in accordance with rules based on requirements of implementation.”), and

modifying the list so that the message is not delivered to the at least one excluded e-mail address (column 4, lines 54-58 teaches the computer readable code devices for provision of transmission control directives by the user which comprise “one or more alias or email address strings to be excluded.”).

As to claim 5, Raghunandan teaches a computer program product comprising a computer readable media on which the computer program of claim 4 is stored (Raghunandan teaches all of the limitations of claim 4 and also teaches a computer usable storage medium in column 4, lines 33-34. It is interpreted that a usable computer storage medium is a type of computer readable media.).

As to claim 6, Raghunandan teaches a computer programmed to enable a computer user exchanging electronic mail (e-mail) messages with other computer users in a computer network, comprising (column 3, lines 55-60 teach “the invention further provides an email transmission apparatus configured to transmit email messages to selected recipients and groups of recipients”. It also discloses the apparatus as a personal computer including a CPU, associated memory, storage devices, and imputer output devices.):

a user-interface software module enabling the user to prepare an e-mail message, the user-interface software module including first input means for enabling the user to provide an indication of e-mail addresses of intended message recipients (column 3, lines 61-62 teach “an

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inputting mechanism for obtaining aliases and transmission control directives from the user,”), and second input means for enabling the user providing an indication of at least one excluded e-mail address to be excluded from the list of destination e-mail addresses (column 4, lines 1-3 teach “an exclusion mechanism for removing specific aliases or email addresses from said defined list or lists of recipients based on the transmission control directives); and

a message compiler software module for generating a list of destination e-mail addresses, said list being generated by including all the addresses provided by the user through the first input means, and removing from the list all the addresses provided by the user through the second input means (column 4, lines 22-31 teach “The said exclusion mechanism includes a means for removing one or more aliases or email addresses from one or more said defined aliases in the list or lists of recipients, in accordance with rules based on requirements of implementation. The said inclusion mechanism includes a means for adding one or more aliases or email addresses to one or more said defined aliases in the list or lists of recipients, in accordance with rules based on requirements of implementation.”); a communication manager software module for causing the message to be delivered to each address in the list (column 4, lines 32-35 teach “computer readable code embodied therein for causing a computer to transmit email to a plurality of recipients”).

As to claim 7, Raghunandan teaches the computer of claim 6, further comprising an address book manager software module enabling the user to (The applicant has disclosed that “the address book 335 is essentially a file, stored in the computer hard-disk, including a table having as many entries as are the number of recipient e-mail addresses stored therein. Each table



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entry, substantially a record, includes a "Name" field, in which the name of the recipient is stored, an "Address" field, in which the e-mail address of the recipient is stored, and a "Group(s) Name" field, storing the name or names of the user-defined recipient group or groups in which the recipient is included." Therefore it is understood that one form of an address book is what Raghunandan teaches as an alias: "Very often, a recipient or group of recipients who are frequently contacted, are identified by an alias (a name string) in order to facilitate identification and/or reduce the burden of repeatedly entering the individual email addresses. An alias may correspond to a group of email addresses and may further make reference to other aliases."):

create user-defined groups of prescribed recipient e-mail addresses (column 4 lines 4-6 teach "an inclusion mechanism for adding specific aliases or email addresses to the aliases in said defined list or lists of recipients."), and

providing the indication of the e-mail addresses intended message recipients and/or the indication of the at least one excluded e-mail address to be excluded from the list of destination e-mail addresses by globally instantiating a respective user-defined group (column 4, lines 22-31 teach "The said exclusion mechanism includes a means for removing one or more aliases or email addresses from one or more said defined aliases in the list or lists of recipients, in accordance with rules based on requirements of implementation. The said inclusion mechanism includes a means for adding one or more aliases or email addresses to one or more said defined aliases in the list or lists of recipients, in accordance with rules based on requirements of implementation." The inclusion and exclusion mechanism instantiate the email lists from the aliases and therefore provide the indication of the e-mail addresses which are to be included and excluded.).

4. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Kulkarni U.S. Patent Application Publication No. 2004/0093382.

As to claim 1, Kulkarni teaches a method of sending an electronic mail (e-mail) message, comprising, under the control of a mail user agent (Kulkarni's abstract teaches "A method of transmitting an electronic mail message addressed to a group of recipients using a group alias by temporarily excluding a member from the group alias without modifying the group alias is provided."):

having a user providing an indication of e-mail addresses of intended message recipients (Paragraph [0007] teaches "According to the present invention, the e-mail message is composed in a manner known in the art, including specifying at least a group alias for addressing the group of recipients."), and

based on said indication by the user, generating a list of destination e-mail addresses (Paragraph [0007] teaches "The message is first transmitted from a first mail server to a second mail server for resolving the group alias into a list of individual addresses."), and

causing the message to be electronically delivered to each of the e-mail addresses in the list, characterised by comprising:

enabling the user providing an indication of at least one excluded e-mail address (Paragraph [0007] teaches "where at least one group member is temporarily excluded from receiving the current message"), and

modifying the list so that the message is not delivered to the at least one excluded e-mail address (Paragraph [0007] teaches “The excluded member is then located within the list of individual addresses and temporarily removed from the list before transmitting the message to the remaining addresses.”).

As to claim 2, Kulkarni teaches the method of claim 1, in which said act of having the user providing an indication of e-mail addresses of intended message recipients includes having the user globally specifying at least one pre-defined group (GROUPa) of e-mail addresses, and said act of generating the list includes putting in the list each of the e-mail addresses of the globally-specified group (Paragraph [0007] teaches “specifying at least a group alias for addressing the group of recipients.”).

As to claim 3, Kulkarni teaches the method of claim 1, in which said act of enabling the user to provide an indication of at least one excluded e-mail address includes having the user globally specifying at least one pre-defined group (GROUPb) of e-mail addresses to be excluded, and said act of modifying the list includes removing from the list each of the e-mail addresses of the globally-specified group of e-mail addresses to be excluded (Paragraph [0034] teaches “To exclude these recipients from receiving the current message, the sender specifies one or more e-mail addresses or group aliases or both in the “Ex” field”).

As to claim 4 Kulkarni teaches a computer program in a working memory of a computer, for sending an electronic mail ( e-mail) message, comprising a mail user agent including means

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for (Paragraph [0010] teaches “The present invention also includes a computer-readable or storage medium embodying program instructions at the electronic mail servers or computing systems of e-mail users for performing the invention as described in the following paragraphs.”):

having a user providing an indication of e-mail addresses of intended message recipients (Paragraph [0007] teaches “According to the present invention, the e-mail message is composed in a manner known in the art, including specifying at least a group alias for addressing the group of recipients.”) and

based on said indication by the user, generating a list of destination e-mail addresses (Paragraph [0007] teaches “The message is first transmitted from a first mail server to a second mail server for resolving the group alias into a list of individual addresses.”), and

causing the message to be electronically delivered to each of the e-mail addresses in the list, characterised by comprising:

enabling the user providing an indication of at least one excluded e-mail address (Paragraph [0007] teaches “where at least one group member is temporarily excluded from receiving the current message”), and

modifying the list so that the message is not delivered to the at least one excluded e-mail address (Paragraph [0007] teaches “The excluded member is then located within the list of individual addresses and temporarily removed from the list before transmitting the message to the remaining addresses.”).

As to claim 5, Kulkarni teaches a computer program product comprising a computer readable media on which the computer program of claim 4 is stored (Paragraph [0010] teaches

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“The present invention also includes a computer-readable or storage medium embodying program instructions at the electronic mail servers or computing systems of e-mail users for performing the invention as described in the following paragraphs.”).

As to claim 6, Kulkarni teaches a computer programmed to enable a computer user exchanging electronic mail (e-mail) messages with other computer users in a computer network, comprising (Paragraph [0010] teaches “The present invention also includes a computer-readable or storage medium embodying program instructions at the electronic mail servers or computing systems of e-mail users for performing the invention as described in the following paragraphs.”):

a user-interface software module enabling the user to prepare an e-mail message, the user-interface software module including first input means for enabling the user to provide an indication of e-mail addresses of intended message recipients, and second input means for enabling the user providing an indication of at least one excluded e-mail address to be excluded from the list of destination e-mail addresses (Paragraph [0007] teaches “According to the present invention, the e-mail message is composed in a manner known in the art, including specifying at least a group alias for addressing the group of recipients. The at least one group member is temporarily excluded from receiving the current message by specifying his address in an "Exclude" field.”); and

a message compiler software module for generating a list of destination e-mail addresses, said list being generated by including all the addresses provided by the user through the first input means, and removing from the list all the addresses provided by the user through the second input means; a communication manager software module for causing the message to be

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delivered to each address in the list (Paragraph [0007] teaches “The message is first transmitted from a first mail server to a second mail server for resolving the group alias into a list of individual addresses. The excluded member is then located within the list of individual addresses and temporarily removed from the list before transmitting the message to the remaining addresses.”).

As to claim 7, Kulkarni teaches the computer of claim 6, further comprising an address book manager software module enabling the user to (Paragraph [0026] teaches “A group alias allows a sender to send a message to a group of recipients simply by specifying the group alias. The group alias has to be first created by specifying a list of individual e-mail addresses of members of the group and assigning a name (group alias) to the list. Thereafter, the group alias may be utilized when addressing a message to the members of this group. A group alias may also include other group aliases or a combination of individual e-mail addresses and group aliases.”):

create user-defined groups of prescribed recipient e-mail addresses (Paragraph [0026] teaches “The group alias has to be first created by specifying a list of individual e-mail addresses of members of the group and assigning a name (group alias) to the list”), and

providing the indication of the e-mail addresses intended message recipients and/or the indication of the at least one excluded e-mail address to be excluded from the list of destination e-mail addresses by globally instantiating a respective user-defined group (Paragraph [0034] teaches the use of group aliases in the exclude line “To exclude these recipients from receiving the current message, the sender specifies one or more e-mail addresses or group aliases or both in the “Ex” field.”).

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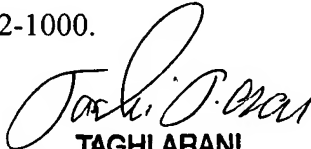
***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gonzalez U.S. Application No. 20030080998, Clissold et al. U.S. Application No. 20030061289, and Raghunandan et al. U.S. Patent No. 6775689.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Kessler whose telephone number is (571) 270-5005. The examiner can normally be reached on Monday through Friday 7:30 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi Arani can be reached on (571)272-3787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
TAGHI ARANI  
PRIMARY EXAMINER  
9/26/07